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TECHNOLOGY CENTER 2100

In re Application of: Wrigley et al.)
Application No. 10/779,807)
Attorney Docket No. 550-526)
Filed: February 18, 2004)
For: DIRECT ACCESS MEMORY)
CONTROL)

**DECISION ON PETITION TO
WITHDRAW RESTRICTION
REQUIREMENT UNDER 37 CFR
§1.144**

This is a decision on the petition filed March 7, 2007 under 37 C.F.R. §1.144 and 37 C.F.R. §1.181 to withdraw an outstanding restriction requirement.

The petition is **GRANTED**.

RELEVANT PROSECUTION HISTORY

- May 5, 2006 Requirement for Restriction/Election mailed identifying 4 Species. Indicated claims 1 and 17 to be generic.
- June 5, 2006 Applicant elect Species 1 with traverse, electing Species disclosed in Figs. 3 and 7, and claims 2, 6-11, 13-16, 18, 21-26, and 28-31. Applicant traversed that species disclosed by Fig. 5 was a subset of those disclosed by Fig. 3, and species disclosed by Fig. 8 was the same as Fig. 3. Applicant also argued that claims 12, 27, and 32 were generic in addition to claims 1 and 17.
- June 30, 2006 FAOM mailed. Applicants arguments were found unpersuasive, and Restriction was made final. Claims 1-12 and 17-27, and 32 were withdrawn from consideration, as being drawn to non-elected Species IV, there being no allowable generic or linking claim. Examiner rejected claims 13-16 and 28-31 over art.
- September 29, 2006 Applicant filed a Request for Reconsideration of the Restriction requirement and also the art rejection. Applicant traversed the restriction requirement on the basis that claim 13 was generic to figs. 3, 5, 7, and 8,

and would result in the examination of Species I, II, and III disclosed in those figures.

December 7, 2006 Final rejection was mailed. Applicants' argument regarding generic claim were found unpersuasive.

March 7, 2007 Instant petition filed, submitting that claims 13 and 28 are generic claims.

June 7, 2007 Applicant initiated interview: Request for reconsideration persuasive, and examiner offers to withdraw finality of action mailed 12/7/06, and issue a new office action.

REGULATIONS AND PRACTICE

37 C.F.R. § 1.143 states:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 C.F.R. § 1.144 states:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

37 C.F.R. § 1.181 states:

- (a) Petition may be taken to the Commissioner:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
 - (3) To invoke the supervisory authority of the Commissioner in appropriate

circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02....

MPEP § 806.04(d) [R-3] states:

Definition of a Generic Claim:

In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim

does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

** In general, a generic claim should *require< no material element additional to those **>required by< the species claims, and ** each of the species >claims must require all the limitations of the generic claim<.

** Once a **>generic claim is allowable<, all of the claims drawn to species in addition to the elected species which *require< all the limitations of the generic claim will ordinarily be * allowable >over the prior art< in view of the *>allowability< of the generic claim, since the additional species will depend thereon or otherwise *>require< all of the limitations thereof. When all or some of the claims directed to one of the species in addition to the elected species do not *>require< all the limitations of the generic claim,

** see MPEP § *>821.04(a)<.

MPEP § 821.01 states:

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

DECISION

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner. 37 C.F.R. § 1.144 states that the applicant may petition the Commissioner after a final requirement for the restriction has been made.

In the above-identified application, the restriction requirement was made final on the FAOM mailed 6/30/06. Applicant filed a request for reconsideration on 9/29/06, prior to the petition of March 7, 2007, in accordance with 37 C.F.R. § 1.143. Examiner maintained the restriction requirement, and issued a final rejection on 12/07/06.

The issue presented in the petition is whether the restriction based on whether claims 13 and 28 are generic claim that reads on more than one species in the instant application.

A review of the record reveals that the Office action mailed May 5, 2006 set forth an election requirement requiring a provisional election between four species identified as (1) Figs. 3 and 7, (2) Fig. 5, (3) Fig. 8, and (4) Fig. 9, and indicating that claims 1 and 17 appear to be generic.

Applicants elected the species of Figs. 3 and 7 with traverse in the response filed May 5, 2006. The examiner, upon reconsideration, adhered to the election requirement and made the election requirement final, and indicated that there were no allowable generic claims in the Non-Final rejection mailed on June 30, 2006. Applicant filed a request for reconsideration, submitting that claim 13 was generic to figs. 3, 5, 7, and 8, and hence generic to the species in the 4 figures. Examiner mailed a Final rejection, finding applicants arguments unpersuasive for the following reasons:

1. Claim 13 and 28 do not read on figs. 9.
2. Species II illustrated by Fig. 5 requires 2 separate registers, which is different from Species I.
3. Species I and III are different because Species I discloses DMAC with a register inside while Species III discloses DMAC without a register.

This petition was then timely filed, on March 7, 2007, along with a request for reconsideration of the final rejection on the grounds that claim 13 is generic to claims 3, 5, 7 and 8.

Applicants' petition alleges that the election requirement is improper because there is significant overlap between the claims of the identified groups of invention due to the presence of generic claims and that the subject matter is sufficiently related such that a thorough search for the subject matter of the elected species would encompass a search for the subject matter of the other species. The petition also alleges that examiner failed to explain how and why claim 13 would not read on figures 3, 5, 7, and 8.

As per MPEP 806.04(d),

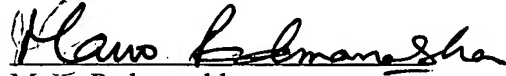
1. a generic claim should read on each of these views;
2. In general, a generic claim should *require no material element additional to those **required by the species claims, and
3. ** each of the species >claims must require all the limitations of the generic claim<.

Claims 13 and 28, seem to meet the requirements set forth above for a generic claim. Further, the reviewer agrees with the examiner's statements in the Interview summary mailed on June 7, 2007, wherein the examiner states that the applicant's arguments were persuasive in the request for reconsideration.

For the above reasons, the petition is **GRANTED**.

The finality of the office action mailed 12/06/2006 is hereby withdrawn.

The application will be forwarded to the examiner for further action.

A handwritten signature in black ink, appearing to read "Mañó Padmanabhan", written over a horizontal line.

Mañó Padmanabhan

Quality Assurance Specialist, Technology Center 2100, Workgroup 2180
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